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In re Application of :
JACOTOT et al. :
Application No.: 10/533,642 :
PCT No.: PCT/EP03/12056 :
Int. Filing Date: 02 October 2003 :
Priority Date: 02 October 2002 :
Attorney Docket No.: 1721-90 :
For: METHOD FOR MODULATORS OF :
MITOCHONDRIAL FUNCTIONING :
AND NEW MODULATORS OBTAINED :

DECISION ON PETITION

This decision is issued in response to applicants' "Petition under 37 CFR 1.47" filed 05 October 2007 to accept the application without the signature of joint-inventor, Dominique Rebouillat.

BACKGROUND

On 02 October 2003, applicants filed international application PCT/EP03/12056 which claimed a priority date of 02 October 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 02 April 2005.

On 03 May 2005, applicants filed a transmittal letter for entry into the national stage in the United States for international application PCT/EP03/12056, which included, among other materials: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a preliminary amendment; and a petition to revive international application. The international application was revived pursuant to 37 CFR 1.137(b) in a "Decision on Petition" dated 24 August 2006.

On 06 March 2007, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. Furthermore, the Notification indicated that a Sequence Listing had not been filed as required by 37 CFR 1.821(c) and (e). The notification set a two-month time limit in which to respond. The notification set a two-month time limit in which to respond.

On 05 October 2007, applicants filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1), (2) and (4) have been satisfied.

Regarding item (2) above, petitioner states that Dominique Rebouillat has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that petitioner has not shown that a bona fide attempt was made to present the application papers (specification, claims, and drawings) to Dominique Rebouillat. The declaration of Chantal Peaucelle states that communications (exhibits 1 and exhibit 4) were mailed to the nonsigning inventor on 26 March 2007 and 27 April 2007 and that Dominique Rebouillat refused to execute the documents. However, it is unclear from the present petition and accompanying documents whether Dominique Rebouillat has been presented with a complete copy of the application

papers as required. The mailing of the oath/declaration is not considered a complete copy of the application. As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, and drawings) were sent to Mr. Rebouillat, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. Lastly, applicants should provide complete translations of Exhibits 1-4.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Dominique Rebouillat under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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